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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,331	09/04/2003	Dennis O. Falaas	48748US019	6100
32692	7590	02/24/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			BISSETT, MELANIE D	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,331

Applicant(s)

FALAAS ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Information Disclosure Statement

1. The information disclosure statement filed 9/4/03 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.
2. Forms PTO-892 from parent applications are not appropriate forms of an information disclosure statement for consideration by the examiner. They are easily confused with Forms PTO-892 from the present case, do not contain the present application number, do not contain columns for the examiner's initials, and are not clearly indicated as information disclosure statements. Signed copies should especially not be submitted as information disclosure statements, since the signed copies can be confused with papers signed by the examiner in the present case. Furthermore, it is noted that some of the references in the forms PTO-892 have been listed twice. The submitted forms PTO-892 from parent cases will be placed in the file but not considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 27, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunning et al. Dunning et al. (US 4,101,698) can be found on the applicant's Form PTO-1449.

5. Dunning teaches laminate structures comprising an adhesive layer, a visually continuous reflective metal layer, a polyurethane elastomeric film layer, and a release coated carrier layer (abstract, figure 1). The reference discusses reinforcing the opacity of the metal layer, indicating that the metal layer already contains a degree of opacity (col. 2 lines 46-48). Metals for the metal layer include chromium, nickel, stainless steel, aluminum, tin, indium, silver, and alloys thereof (col. 2 lines 1-13). The elastomeric film is preferably transparent to allow the metal layer to show through (col. 4 lines 32-59).

6. Claims 17-18, 21, 23-27, and 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Nippon Carbide. The examiner refers to the English language equivalent of Nippon Carbide, Ochi et al. Ochi et al. (US 5,225,267) can be found on the applicant's Form PTO-1449.

7. The reference teaches a laminated film resin comprising a PVC resin film, a polyurethane resin layer, and a metal layer adhering to the polyurethane layer

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(abstract). In this case, PVC serves as a clear coat protective layer (col. 9 lines 13-21). The metal layer is visible through the PVC and polyurethane layers (col. 2 lines 61-68). Metals for the metal layer include aluminum, gold, silver, nickel, and chromium (col. 14 lines 51-54). The polyurethane layer includes a crosslinking agent (col. 11 line 56-col. 12 line 5) and may also include colorants (col. 13 lines 3-6). Figures 1 and 2 show adhesive backings on the metal layer and release backings on the adhesive layer. Also, surface coatings are noted (col. 9 lines 22-24).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nippon Carbide in view of Dunning et al.

10. Nippon Carbide applies as above, teaching several metals for the metal layers but failing to mention the use of indium or tin materials or the use of primers. Dunning applies as above, where indium and tin materials are noted as equivalents to other metals, including nickel, silver, chromium, and aluminum (col. 2 lines 1-13). The metals are highly reflective and capable of being vacuum deposited. Thus, it is the examiner's position that it would have been prima facie obvious to use indium, tin, or alloys thereof

in Nippon Carbide's invention with the expectancy of forming equally reflective and processible metal layers.

11. Also, Dunning teaches that primer layers can be used on the metal layer to improve adhesion between the laminate and the substrate to be bonded (col. 6 lines 14-35). Thus, it is the examiner's position that it would have been prima facie obvious to use a primer layer in the laminates of Nippon Carbide to improve adhesion to bonding substrates.

12. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunning et al. in view of Kunevicius.

13. Dunning applies as above, noting the application of PSA materials to the metal layer but failing to mention the use of an adhesive foam tape. Kunevicius teaches that foam tapes are used to apply molding materials to automobile body, where the foam serves to improve vibration absorption to prevent delamination (col. 4 lines 18-51). It is the examiner's position that it would have been prima facie obvious to use foam tapes as the adhesive in Dunning's invention to improve vibration absorption and prevent delamination.

14. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nippon Carbide in view of Kunevicius.

15. Nippon Carbide applies as above, noting the application of PSA materials to the metal layer but failing to mention the use of an adhesive foam tape. Kunevicius teaches

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that foam tapes are used to apply molding materials to automobile body, where the foam serves to improve vibration absorption to prevent delamination (col. 4 lines 18-51).

It is the examiner's position that it would have been prima facie obvious to use foam tapes as the adhesive in Nippon Carbide's invention to improve vibration absorption and prevent delamination.

Double Patenting

16. Applicant is advised that should claim 25 be found allowable, claims 32 and 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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18. Claims 17-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially overlapping subject matter. Patented claim 1 recites a metallized film comprising a continuous, opaque metal layer in direct contact with an aliphatic polyurethane substrate, where the substrate is further defined. Patented claims 6-9 and 11 recite further color or clear coatings on the polyurethane substrate, where the metal layer is visible through the substrate and coating(s). Thus, the patented claims are encompassed by the limitations of present claims 17 and 23. The patented claims also recite the claimed metals, a crosslinking agent, and a primer layer.

19. Claims 24-27, 29, and 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of Nippon Carbide. The patented claims apply as above, failing to mention backing layers or colorants used in the polyurethane substrate. Nippon Carbide (referenced by Ochi et al.) discloses laminate films comprising metal layers, polyurethane resin layers, and a top resin layer. Nippon Carbide teaches that adhesive layers and release substrates are used to adhere the laminate to a substrate and to protect the laminate from contamination, respectively (col. 16 lines 1-22). Thus, it would have been obvious to include extra adhesive or backing substrate layers to the

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patented claims to improve adhesion and protection of the claimed laminates. Also, Nippon Carbide teaches coloring the polyurethane layer to achieve a desired appearance (col. 13 lines 3-6). It would have been obvious to add colorants to the claimed polyurethane resin layer to achieve a desired appearance.

20. Claims 28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of Nippon Carbide and Kunevicius. Nippon Carbide and the patented claims apply as above, noting the application of PSA materials to the metal layer but failing to mention the use of an adhesive foam tape. Kunevicius teaches that foam tapes are used to apply molding materials to automobile body, where the foam serves to improve vibration absorption to prevent delamination (col. 4 lines 18-51). It is the examiner's position that it would have been prima facie obvious to use foam tapes as the adhesive in the invention to improve vibration absorption and prevent delamination.

21. Claims 17-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,641,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially overlapping subject matter. Patented claim 1 recites a metallized film comprising a continuous, opaque metal layer and a transparent polyurethane substrate, where the substrate is further defined. Patented

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claim 17 recite furthers color or clear coatings on the polyurethane substrate, where the metal layer is visible through the substrate and coating(s). Also, claims 9-10 and 14 recite backing and adhesive layers to be attached to the metal layer. Thus, the patented claims are encompassed by the limitations of present claims 1, 17, 9-10, and 14. The patented claims also recite the claimed metals, crosslinking agent, primer layer, and colorants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett
Patent Examiner
Art Unit 1711

mdb